

RECEIVED
CENTRAL FAX CENTER

APR 22 2008

REMARKS

In the non-final Office Action mailed January 23, 2008, claims 1, 3-27, 29-40, and 49-51 were pending. Claims 1, 3-9-14, 16-30, 32-40, and 49-51 were rejected, and claims 15 and 31 were indicated to be allowable if rewritten in independent form incorporating the base claim and any intervening claims. Claims 20 and 21 are cancelled in this response, claims 1, 19, 27, 38, 40, 49 and 50 have been amended and claims 53-57 have been added. Reconsideration and allowance of the subject application as amended are hereby requested.

Claims 1, 21, and 40 were objected to since the examiner does not believe that the guide flanges are on opposite sides of the guide members, but rather when the guide surfaces are facing one another the guide flanges are opposite each other along the length of the guide members. Claims 1, 19 (which incorporates claim 21) and 40 have been amended as requested by the examiner. Withdrawal of the objection to these claims is respectfully requested.

Claims 1, 9, 12-14, 17-21, 26, 29, and 37-40 were rejected as understood under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,758,159 to Weissman (hereafter, "Weissman"). Claim 1 includes the features of "wherein said guide surfaces of said first and second guide members oriented toward one another when said first and second guide members are mounted on said frame and said guide flanges are opposite each other along a length of said first and second guide members." The Office Action states that the "examiner believes that when the device of Weissman is viewed from the distal end the guide members from [sic] L-shapes. The examiner believes that the guide flange of one guide member is on the right side of the guide member and the guide flange of the other guide member is on the left side of the guide member." Office Action, page 3.

The "guide flanges" of Weissman are clearly aligned with each other on the same side of grasping legs 20, 48. The relationship of L-shaped grasping legs 20, 48, while obscured in Figure 2 included with the Office Action, is clearly shown and readily discerned from Figures 1, and 3-5 of Weissman. Weissman discloses that grasping legs 20, 48 include notches 88, 92 in inner surfaces 90, 94, respectively. Weissman further discloses that, "as can best be seen in FIG. 4, the grasping legs 20, 48 can grasp two corners of a rectangular workpiece 82 within the notches 88, 92 to assure the parallel relationship by grasping three sides of the workpiece and

Response to Non-Final Office Action
Application Serial No. 10/680,358
Atty Docket No. MSDI-245/PC819.00
Page 12 of 19

securing the workpiece in proper parallel relationship." Figure 3 of Weissman shows each notch 88, 92 with a hidden line, indicating that each notch 88, 92 is hidden by the "guide flange" of each of the grasping legs 20, 48. If arranged according to the belief of the examiner, one of the notches 88, 92 would be visible when viewed from the side. Accordingly, Weissman discloses that each "guide flange" is located on the same side of the grasping legs 20, 48 since each hides the respective notch 88, 92 in Figure 3. This is further shown in Figure 4, where workpiece 82 is situated between grasping legs 20, 48 and each notch 88, 92 is located so that the "guide flanges" defined by notches 88, 92 extend along the back side of workpiece 82 in Figure 4. If the "guide flanges" were arranged according to the belief of the examiner, then one of the "guide flanges" would obscure the portion of the side of workpiece 82 adjacent thereto. Also, Figure 5 of Weissman with workpiece 82 removed shows notches 88, 92 opening along the same side of grasping legs 20, 48 and both "guide flanges" are on the side of grasping legs 20, 48 that is opposite the side that notches 88, 92 open. Therefore, for at least these reasons, Weissman fails to disclose the elements arranged as recited in claim 1 and withdrawal of this basis of the rejection of claim 1 is respectfully requested.

Claim 9, 12-14, 17 and 18 depend from claim 1 and distinguish Weissman at least for the reasons claim 1 does. Withdrawal of this basis of the rejection of these claims is respectfully requested.

Turning to independent claim 19, it has been amended and also recites "a guide flange extending along only one of said first and second sides, said guide flange projecting from said guide surface of the corresponding one of the first and second guide members toward the guide surface of the other of said first and second guide members, wherein when said guide surfaces are facing one another said guide flanges are opposite each other along a length of said guide members" For the same reasons provided above with respect to claim 1, Weissman does not disclose or suggest these features, and claim 19 distinguishes Weissman along with claims 26, 29, and 37 depending therefrom.

Amended claim 38 includes the features of "wherein said frame is transversely oriented to said guide members adjacent proximal ends of said guide members, said frame being configured relative to said proximal ends of said guide members so that said guide members are

Response to Non-Final Office Action
Application Serial No. 10/680,358
Atty Docket No. MSDI-245/PC819.00
Page 13 of 19

unobstructed between said guide surfaces at said proximal end to define a proximal opening therebetween for receipt of an implant through said opening for positioning between said guide surfaces of said guide members." Support for the amendment to claim 38 may be found, for example, in paragraph [0029] and Figures 2 and 4 of the publication of the present application. As shown in Figures 1 and 4, grasping legs 20, 48 of Weissman are not unobstructed between guide surfaces along notches 88, 92 at proximal ends of grasping legs 20, 48 to define a proximal opening between notches 88, 92 for receipt of an implant for positioning therebetween. Rather, notches 88, 92 are each closed at the proximal ends of grasping legs 20, 48. Furthermore, guide members 24, 26 and screw member 62 extend between and obstruct grasping legs 20, 48 between their proximal ends and prevent the placement of workpiece 82 between grasping legs 20, 48 through an opening at the proximal ends of grasping legs 20, 48. Therefore, withdrawal of this basis of the rejection of claim 38 is respectfully requested.

Claims 39-40 depend from claim 38 and are allowable at least for the reasons claim 38 is allowable and for other reasons. For example, amended claim 40 recites "wherein said guide members include guide flanges extending therealong adapted to confine an implant therebetween as the implant is moved along said guide surfaces, wherein each guide member includes a single guide flange and when said guide surfaces face one another said guide flanges are opposite each other along a length of said first and second guide members" and distinguishes Weissman for the reasons provided above with respect to claim 1. Withdrawal of this basis of the rejection of claims 39-40 is respectfully requested.

Claims 3-8 and 22-25 were rejected as understood under 35 U.S.C. § 103(a) as being unpatentable over Weissman in view of U.S. Patent No. 5,431,658 to Moskovich. Claims 3-8 depend from claim 1, and distinguish the cited references at least for the reasons claim 1 does. Claims 22-25 depend from claim 19 and distinguish the cited references at least for the reasons claim 19 does. Withdrawal of the rejection of claims 3-8 and 22-25 is respectfully requested.

Claims 1, 11-14, 16-21, 29, 30, 32-40 and 49-51 were rejected as understood under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,088,472 to Fakhrai in view of U.S. Patent No. 4,165,746 to Burgin. The combination of Fakhrai and Burgin fails to teach or suggest the features in claim 1. Fakhrai discloses a frame 22 that extends between the proximal ends of

Response to Non-Final Office Action
Application Serial No. 10/680,358
Atty Docket No. MSDI-245/PC819.00
Page 14 of 19

arms 24, 26 and arms 24, 26 extend distally from frame 22. It is not clear what the Examiner considers to be guide surfaces of arms 24, 26 since the Office Action fails to identify any elements corresponding to such. Presumably, the guide surfaces are not the facing surfaces of blades 32, 33 since it is indicated the Fakhrai fails to disclose a device where the guide surfaces of each guide member face towards one another. Burgin was asserted to teach guide surfaces of guide members that are capable of being oriented toward each other in order to produce a clamping force between the guide members. It is then asserted that it would have been obvious to somehow manufacture the device of Fakhrai were guide surfaces of arms 24, 26 are oriented towards one another in view of Burgin in order to produce a clamping force between arms 24, 26.

It is respectfully submitted that the asserted modification to Fakhrai renders it inoperable for its intended purpose, and one of ordinary skill in the art would have no reason to modify the retractor of Fakhrai to produce to a clamping force between arms 24, 26. Fakhrai teaches a retractor 23 that is configured to open the sternum with blades 32 and 33 adapted to secure the sternum after it is cut. See col. 3, line 27-50. If blades 32, 33 of Fakhrai are considered to be the guide flanges, the modification to Fakhrai proposed in the office action orients blades 32 and 33 so that their elongate sides extend toward one another, rendering retractor 23 inoperable for retracting a sternum. It would not be possible to position arms 24, 26 sufficiently close together for insertion into an incision in the sternum since blades 32, 33 are located on the same side of arms 24, 26 if arms 24, 26 are rotated so that the blades extend toward one another. It is not possible to rotate arms 24, 26 so that blades 32, 33 extend toward one another and are also located opposite one another along a length of arms 24, 26. Thus, Fakhrai teaches away from the modification of it proposed in the Office Action since the modification renders it inoperable for its intended purpose. Furthermore, even if arms 24, 26 were oriented as suggested in the Office Action, blades 32, 33 are not opposite each other along a length of arms 24, 26, but rather are aligned with each other. Therefore, Fakhrai and Burgin are not combinable to teach or suggest all the elements of claim 1 or claim 19, and withdrawal of this basis of the rejection of claims 1 and 19 is respectfully requested.

Response to Non-Final Office Action
Application Serial No. 10/680,358
Atty Docket No. MSDI-245/PC819.00
Page 15 of 19

Claims 12-14 and 16-18 depending from claim 1 and claims 29, 30 and 32-37 depending from claim 19 also distinguish Fakhrai and Burgin at least for the reasons their respective base claims do and for other reasons. In support of these rejections, the Office Action asserts that Fakhrai discloses a device comprising a frame in order to move the guide members parallel to each other, and that Burgin teaches a device comprising a frame including a stationary arm and a moving arm in order to move the guide members parallel to each other. Fakhrai does not teach any frame or movement of arms 24, 26 parallel to one another. In fact, Fakhrai specifically teaches that it is critical for the arms to move in a non-parallel relationship. See col. 3, lines 31-35 and col. 4, lines 8-14. Burgin also teaches moving contacting portions 54, 56 in a non-parallel manner by rotating arms 22, 24 in straps 34, 36 with proximal handle portions 28, 30. Straps 34, 36 include a hinge 26 with hinge pin 43 that is loosened to allow rotation of arms 22, 24 in straps 34, 36 and tightened to frictionally secure arms 22, 24 in position in straps 34, 36. The hinge pin 43 at hinge 26 extends through mating holes 38 of straps 34, 36 to prevent movement of arms 22, 24 toward and away from one another in a parallel fashion. There is no teaching or suggestion in Burgin of parallel movement of arms 22, 24 or contacting portions 54, 56. Nor is there any disclosure or teaching of a frame with a stationary arm and a movable arm.

Thus, Fakhrai and Burgin do not teach or suggest "wherein said frame portion is structured to move said guide members away from and toward one another with said guide surfaces remaining parallel to one another" as recited in claim 18 and as similarly recited in claim 37. Furthermore, Fig. 4 of Burgin does not disclose that straps 34, 36 include a movable strap and a fixed strap or that straps 34, 36 define any C-shaped opening therebetween. Thus, the combination of Fakhrai and Burgin do not teach or suggest "wherein said stationary arm and said movable arm define a C-shaped central opening therebetween" as recited in claim 16 and as similarly recited in claim 32. Furthermore, claims 33-36 recite particular arrangements of the movable arm and stationary arm that are not disclosed in Burgin since straps 34, 36 are both fixed relative to one another when engaged by hinge pin 43 and are each removable when released by hinge pin 43. Therefore, claims 16, 18, 32-37 are independently patentable and withdrawal of the rejection of claims 12-14 and 16-18 depending directly or indirectly from claim 1 and claims 29, 30 and 32-37 depending directly or indirectly from claim 19 is respectfully requested.

Response to Non-Final Office Action
Application Serial No. 10/680,358
Atty Docket No. MSDI-245/PC819.00
Page 16 of 19

Claim 38 recites "a distal portion including a first guide member and a second guide member extending along said first guide member, said first and second guide members each including a guide surface oriented toward the guide surface of the other of said first and second guide members...." As discussed above with respect to claims 1 and 19, Fakhrai teaches away from the modification proposed in the Office Action, and one of ordinary skill in the art would have no rational reason to modify Fakhrai as proposed in the Office Action.

Furthermore, claim 38 recites "a proximal portion including a frame coupled to said first and second guide members, said frame being structured to move said first and second guide members toward and away from one another with said guide surfaces remaining generally parallel...." As discussed above with respect to claims 12 and 37, neither Fakhrai nor Burgin teach or suggest parallel movement of guide surfaces, and in fact teach away from such an arrangement. For this additional reason, claim 38 is allowable.

Claims 39-40 depending from claim 38 are also not taught in Fakhrai and Burgin. Claim 39 recites "wherein said frame includes a stationary arm coupled to one of said first and second guide members and a movable arm coupled to the other of said first and second guide members, said movable arm further being further movably coupled with said stationary arm." As discussed above, Burgin does not disclose that one of the straps 34, 36 is stationary and one is movable. Rather, both are either fixed by hinge pin 43 or are movable when hinge pin 43 is released.

Claim 40 recites "wherein said guide members include guide flanges extending therealong adapted to confine an implant therebetween as the implant is moved along said guide surfaces, wherein each guide member includes a single guide flange and when said guide surfaces face one another said guide flanges are opposite each other along a length of said first and second guide members." As discussed above with respect to claims 1 and 19, neither Fakhrai nor Burgin disclose or teach guide flanges opposite each other along the length of the arms 24, 26 when guide surfaces are facing one another.

Claim 49 recites "a distal portion including a first guide member extending distally from said first arm and a second guide member extending distally from said second arm, said first and second guide members being movable toward and away from one another by moving said first arm relative to said second arm, wherein said frame is transversely oriented to said guide

Response to Non-Final Office Action
Application Serial No. 10/680,358
Atty Docket No. MSDI-245/PC819.00
Page 17 of 19

members adjacent proximal ends of said guide members, said frame being configured relative to said proximal ends of said guide members so that said guide members are unobstructed between said guide surfaces at said proximal end to define a proximal opening therebetween for receipt of an implant through said opening for positioning between said guide surfaces of said guide members...." Fakhrai teaches frame 22 extending between the proximal ends of arms 24, 26 so that the space between arms 24, 26 is obstructed thereby. Burgin similarly teaches straps 34, 36 extending between and obstructing the space between arms 22, 24. Therefore, the combination fails to teach or suggest at least these features in claim 49 and withdrawal of the rejection of claim 49 is respectfully requested along with claim 51 depending from claim 49.

Amended claim 50 recites "a distal portion including a first guide member extending distally from said first arm and a second guide member extending distally from said second arm, said first and second guide members being movable toward and away from one another in parallel relation by moving said first arm relative to said second arm...." As discussed above, neither Fakhrai nor Burgin teach or suggest parallel movement of arms 24, 26 or arms 22, 24. In addition, Fakhrai teaches away from parallel movement of arms 24, 26. Therefore, Fakhrai and Burgin are not combinable to teach or suggest all the elements of claim 50. Withdrawal of the rejection of this claim is respectfully requested.

Claims 3-9 and 22-26 were rejected as understood under 35 U.S.C. § 103(a) as being unpatentable over Fakhrai in view of Burgin and further in view of Moskovich. Claims 3-9 depend from claim 1, and distinguish the cited references at least for the reasons claim 1 does. Claims 22-25 depend from claim 19 and distinguish the cited references at least for the reasons claim 19 does. Withdrawal of the rejection of claims 3-9 and 22-26 is respectfully requested.

Claims 10 and 27 were rejected as understood under 35 U.S.C. § 103(a) as being unpatentable over Fakhrai in view of Burgin in view of Moskovich and further in view of Zinkel. Claim 10 depends from claim 1 and is allowable at least for the reasons claim 1 is allowable. Furthermore, amended claim 27 recites "a distal portion including a first guide member extending distally from said movable arm and a second guide member extending distally from said stationary arm, said first and second guide members each including a guide surface oriented toward the guide surface of the other of said first and second guide members, said first and

Response to Non-Final Office Action
Application Serial No. 10/680,358
Atty Docket No. MSDI-245/PC819.00
Page 18 of 19

second guide members being movable toward and away from one another by moving said movable arm relative to said stationary arm while maintaining said guide surfaces in parallel relation...." As discussed above, Fakhrai and Burgin fail to teach these features. Furthermore, Moskovich and Zinkel disclose non-parallel movement of facing surfaces of the guide and retractor disclosed therein, respectively. Therefore, claim 27 is allowable and withdrawal of the rejection of the same is respectfully requested.

New claims 53-57 have been added in this response and are directed along the lines of claims 15 and 31 but depend from other independent claims 50, 49, 38, 27 and 11, respectively. Claims 53-57 are allowable at least for the reasons claims 15 and 31 are allowable. Claims 53-57 find support in Figures 1, 2 and 4 and paragraph [0037] of the publication of the present application.

It is respectfully submitted that the present application including claims 1, 3-19, 22-27, 29-40, and 49-51 is in condition for allowance. Reconsideration of the present application in view of the foregoing amendments and remarks is respectfully requested. The Examiner is welcome to contact the undersigned to resolve any outstanding issues with regard to the present application.

Respectfully submitted,

By:



Douglas A. Collier
Reg. No. 43,556
Krieg DeVault LLP
One Indiana Square, Suite 2800
Indianapolis, Indiana 46204-2079
(317) 238-6333 voice

Response to Non-Final Office Action
Application Serial No. 10/680,358
Atty Docket No. MSDI-245/PC819.00
Page 19 of 19

BEST AVAILABLE COPY